

### **REMARKS**

In the Office Action dated June 26, 2007, the Examiner rejected claims 1-11, 13-15, and 18-27. By the present response, claims 1, 5, 8, 10, 15, and 19-27 are amended, and claims 12 and 16 are cancelled. No new matter has been added. Upon entry of the amendments, claims 1-11, 13-15, and 17-27 will remain pending in the application. In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of all pending claims.

### **Allowable Claims**

The Examiner objected to claims 12, 13, 16 and 17, but stated they would be allowable if rewritten into independent form. *See* Office Action, page 10. Applicants would like to thank the Examiner for indicating the potential allowability of the referenced claims. Applicants have incorporated the allowable subject matter into the independent claims from which the above referenced claims depend, as will be discussed in further detail below.

### **Rejections under 35 U.S.C. § 101**

In the Office Action, claims 25-27 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner stated that “[c]laims 25-27 recite an ‘image,’ which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material.” *See* Office Action, page 2. Applicants respectfully traverse this rejection. Applicants contend that the images recited in claims 25-27 are not intended to impart functionality to a computing device. Rather, claims 25-27 are independent product-by-process claims, defining the resulting image in terms of the method in which the image is created. *See* M.P.E.P. § 2173.05; *In re Luck*, 476 F.2d 650, 177 U.S.P.Q. 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 U.S.P.Q. 145 (CCPA 1969). Applicants further contend that the resulting image of claims 25-27 is different from those obtained in the prior art due to the novel

method of selectively obfuscating indicia in the resulting image, as disclosed in the present Application. Applicants have further amended claims 25-27 to specifically recite that the resulting images are “stored in a computer readable medium.” As such, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 101.

**Rejections under 35 U.S.C. § 112, Second Paragraph**

Claim 13 was rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the Examiner stated that the limitation “*the* textual indicia to remain decipherable” lacks sufficient antecedent basis. *See* Office Action, page 3. Applicants have amended independent claim 10, from which claim 13 depends, in order to correct this error. In view of these amendments, Applicants respectfully request withdrawal of the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 102**

In the office action, the Examiner rejected claims 1-4, 6, 7, 10, 14, 19, 20, 22, 23, 25, and 26 under 35 U.S.C. § 102(e) as being anticipated by Bates et al., U.S. Patent No. 6,735,347 (hereinafter “Bates”). Applicants respectfully traverse these rejections. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter.

***Independent Claims 1, 10 and 15 are not anticipated by Bates***

As discussed previously, the Examiner indicated the presence of allowable subject matter in claims 12 and 16, dependent respectively from independent claims 10 and 15. Specifically, the Examiner stated that “[n]either Bates or Jordan [U.S. Patent No. 6,823,203], alone or in combination, teach or suggest *comparing the text identified via*

OCR to a list of textual indicia to remain in the image, as claimed.” See Office Action, page 10. (Emphasis added).

Independent claim 10, as amended, incorporates allowable subject matter from claim 12. Specifically, independent claim 10 recites, *inter alia*, “comparing the identified textual indicia to a list of textual indicia to remain decipherable in the reconstructed image.”

Independent claim 15, as amended, recites, *inter alia*, “comparing the identified textual indicia to a list of textual indicia to be rendered undecipherable in the reconstructed image.” (Emphasis added). Although independent claim 15 recites a list of indicia to be rendered *undecipherable*, as opposed to a list of indicia to remain *decipherable*, Applicants believe such subject matter to be allowable. Applicants contend that if comparing indicia to a list of indicia to remain decipherable in determining the indicia that is to be obfuscated is allowable subject matter, as so indicated by the Examiner in claims 12 and 16, then the opposite must also hold true. That is, the comparison of indicia in an image to a list of indicia to be rendered undecipherable in determining the indicia that is to be obfuscated is also allowable subject matter not disclosed by the prior art. Accordingly, claim 15 incorporates the latter embodiment. Furthermore, the present Application also discloses the possibility of such an embodiment:

[The comparison] step 142 may include a comparison of specific indicia to a list of indicia, formats for indicia, or any other suitable basis for distinguishing text and indicia that should be rendered indiscernible in the final image from indicia that should be left viewable and readable.

Specification, page 16, lines 27-30. (Emphasis added).

Moreover, independent claim 1, as amended, incorporates both the allowable subject matter incorporated into claims 10 and 15 and is believed to be in condition for allowance. Specifically, independent claim 1 recites, *inter alia*, “comparing the indicia to

a list of indicia to remain *decipherable* or to a list of indicia to be rendered *undecipherable* in the reconstructed image.” (Emphasis added).

Because Applicants have incorporated allowable subject matter of claims 12 and 16 into their respective parent claims, Applicants believe that independent claims 1, 10, and 15, as amended, are now in condition for allowance. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102(e) and allowance of independent claims 1, 10 and 15, as well as all claims depending therefrom.

#### **Remaining Claims**

Claims 19 and 22, as amended, recite subject matter that is similar to that of claim 1; claims 20 and 23, as amended, recite subject matter that is similar to that of claim 10; and claims 21 and 24, as amended, recite subject matter that is similar to that of claim 15. Thus, for the reasons discussed above with regard to the patentability of claims, 1, 10, and 15, claims 19 and 22, claims 20 and 23, and claims 21 and 24, respectively, are believed to be patentable. Further, claims 25, 26 and 27 are product-by-process claims using the methods set forth in claims 1, 10, and 15, respectively. As discussed above, claims 1, 10, and 15 have been amended to incorporate allowable subject matter and are believed to be in condition for allowance. Accordingly, Applicants respectfully request allowance of claims 19-27.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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